

Section c.) Remarks.

This reply is in response to the Office Action dated June 18, 2003. The claims stand rejected as being anticipated under Section 102 (b) by Akamatsu (Japanese Publication Number 10-251517).

Pending Claims 1-6 and 13 are not anticipated by Akamatsu because Akamatsu teaches using only one solid powder that is made of the same material, in two separate fractions, each fraction of the same material having different particle diameters. In contrast, applicants' invention as defined in Claim 1 is directed to using two different solid powders, each made of a different material one from the other, and in which each different solid powder has a particle diameter that is different from the particle diameter of the other solid powder.

This difference provides the new and unexpected results as shown in Table 1 in applicants' specification. Thus, Application Examples 1-3 contained two different solid powders made of different materials, i.e., calcium carbonate and glass beads. Comparative Examples 1 and 2, on the other hand, contained the same solid powder, i.e., glass beads, in two different sizes. Comparative Example 2 is generally representative of the type of compositions taught by Akamatsu, i.e., in which a single solid powder of the same material in two different sizes is employed.

As a result, Table 1 shows that the Vibration Damping Characteristics of each of the Application Examples 1-3 changed less over a temperature range of -20 °C to 60 °C, than the corresponding Vibration Damping Characteristics of each of Comparative Examples 1 and 2 over the same range.

Akamatsu also fails to teach using the combination of (i) calcium carbonate as one of the solid powders, and (ii) another solid powder which is an inorganic powder other than calcium carbonate, a polyethylene resin powder, an acrylic resin powder, or a silicone resin powder.

It should be noted that new and unexpected results are probative of novelty and unobvious. For example, in *In re Soni*, 54 F.3d 746, 34 USPQ2d 184, (Fed. Cir. 1995), the Court stated:

"One way for a patent applicant to rebut a *prima facie* case of obviousness is to make a showing of "unexpected results," *i.e.*, to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. The basic principle behind this rule is straightforward - that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious".

In view of the above, it is considered that the pending claims distinguish over the cited reference for the reasons stated, and the Examiner is requested to withdraw the rejection and pass the case to issue.

Respectfully submitted,

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